

1014.1043

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Paola AMMANNATI et al.
Serial No. : 10/530,067
Filed : March 31, 2005
For : ENZYMATIC TREATMENT OF
RETINITIS PIGMENTOSIS
Examiner : Lisa Joe Hobbs
Group Art Unit : 1657
Confirmation No. : 7558

PETITION TO WITHDRAW OFFICE ACTION UNDER 37 C.F.R. § 1.181

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22312-1450

Dear Sir:

As indicated in a Notice Of Election filed by Applicants on this date, Applicants elected preliminarily Group I (claims 1-8), with traverse, for prosecution in this Application.

By this Petition, first Applicants confirm the attempts made during the week of July 16, 2007 to contact Examiner Lisa Hobbs and, thereby, bring to Examiner Hobbs' attention (i) that the subject Office Action, dated June 22, 2007, does *not* indicate a Shortened Statutory Period For Reply, (ii) that the Office Action Summary document, Form PTOL-326, received by counsel had not been filled out by the Examiner, and (iii) to request that a new Office Action be mailed properly indicating the Shortened Statutory Period For Reply so that the document could be appropriately docketed by counsel's firm for response. A copy of the Office Action is attached hereto.

Applicants' counsel, however, was advised that Ms. Hobbs was on vacation.

Applicants also confirm, by this Petition, their attempts to contact Supervisory Examiner Jon

Weber on Friday, July 20, 2007 regarding the aforementioned issue.

Applicants' counsel was advised that Examiner Weber was also out of the Office.

Furthermore, by this Petition, Applicants confirm a telephone discussion with Supervisory Examiner Weber on July 23, 2007, during which Applicants' counsel advised Examiner Weber (i) that the subject Office Action indicated no Shortened Statutory Period For Reply, and (ii) that none of the information required to be listed in the Office Action Summary was provided.

Accordingly, Applicants' counsel requested that a new Office Action be mailed properly indicating a Shortened Statutory Period For Reply so that the document could be appropriately docketed by counsel's firm for response.

In reply, after, we understand, Examiner Weber had consulted the "Team Leader" in charge of this Group Art Unit and other Supervisory Patent Examiners, Examiner Weber advised Applicants' counsel that, on page 2 of the Office Action copy provided on PRIVATE PAIR, Form PTOL-326 indicated a Shortened Statutory Period of "1" month or 30 days whichever is longer. Examiner Weber stated that, despite our indication that the corresponding line in the paper copy provided to Applicants was "*blank*", it is the official position of the Patent Office that what is indicated on PRIVATE PAIR is the official record for an Application. Moreover, Examiner Weber continued, in the event of any error detected in a paper copy received from the Patent Office, Applicants are required to look to PRIVATE PAIR, and only if the same error exists on PRIVATE PAIR will the Patent Office issue a corrected Office Action.

As if to patronize Applicants and their counsel, Examiner Weber suggested that Applicants'

counsel should have assumed that the deadline for response to the Office Action, which is a Restriction Requirement, is 1 month or thirty days, whichever is longer, asking counsel, “How long have you been practicing?”, arguing that the Office Action, even with the “blank”, indicates a deadline for response of thirty days, and then asking counsel, “what’s the difference between one month and thirty days?”

We respectfully state that official notice of deadlines for response to any Office Action is as important for clerical staff who receive the paperwork from the Patent Office, on Applicants’ behalf, and must know what deadline to docket for response, as it is for counsel. It is also required by law. By Examiner Weber’s logic, if a First Office Action issued on the merits and the same space in the Office Action Summary was left blank, the deadline for response would be thirty days, which is contrary to Patent Office rules, but yet Applicants’ counsel obviously should know that the shortened statutory period for such a response is three (3) months.

We respectfully submit that the deadline for response to any Office Action must be expressly indicated, and that the deadline for response should not be a “guessing game” on the part of Applicants’ counsel or his clerical staff, nor should it require investigation. Indeed, the issue at hand is one of proper legal record and proper application of rules promulgated by the Patent Office.

Upon accessing PRIVATE PAIR on this date, and inspecting the subject Office Action as provided there, although Form PTOL-326, we understand, is generated and filled out electronically by Examiners, a *handwritten “1” - apparently in pencil* - appears in the blank provided for the Shortened Statutory Period as shown in PRIVATE PAIR. Clearly, the Office Action was manually

altered by someone, after being prepared by the Examiner and a copy printed for mailing to Applicants, which alteration is also considered improper.

We believe that the Supervisory Examiner's refusal to withdraw the Office Action and mail a new one, properly indicating not only a Shortened Statutory Period For Response, but also the information required under the "Status", "Disposition of Claims", etc. which was not provided as well, was improper.

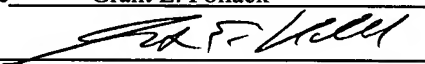
Accordingly, Applicants respectfully request that the present Office Action be withdrawn and that a new one be issued, so that Applicants are given adequate time to respond fully to the Restriction Requirement intended to be sent by the Examiner.

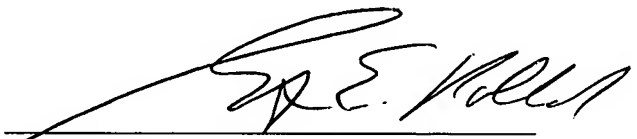
Respectfully submitted,

Dated: July 23, 2007

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail, in an envelope with sufficient postage addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 23, 2007

Name Grant E. Pollack

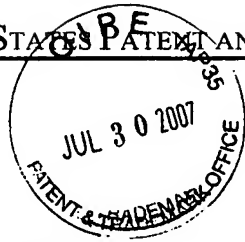

Signature


Grant E. Pollack, Esq.
Registration No. 34,097
POLLACK, P.C.
The Chrysler Building
132 East 43rd Street, Suite 760
New York, New York 10017
Telephone: (646) 265-1468
Facsimile: (646) 253-1276
E-mail: gpollack@pollackpc.com

Attorney for Applicants



UNITED STATES PATENT AND TRADEMARK OFFICE



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,067	03/31/2005	Paola Ammannati	1014.1043	7558
41226 7590 06/22/2007 POLLACK, P.C. THE CHRYSLER BUILDING 132 EAST 43RD STREET, SUITE 760 NEW YORK, NY 10017			EXAMINER HOBBS, LISA JOE	
			ART UNIT 1657	PAPER NUMBER
			MAIL DATE 06/22/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

RECEIVED JUN 30 2007
POLLACK, P.C.
The Chrysler Building
132 East 43rd Street, Suite 760
New York, NY 10017

Office Action Summary

Application No.

10/530,067

Applicant(s)

AMMANNATI ET AL.

Examiner

Lisa J. Hobbs

Art Unit

1657

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-8, drawn to a pharmaceutical kit containing enzymes A – D at specified concentrations and the method of preparation of the kit using the enzymes.

Group II, claim(s) 9 and 10, drawn to a method for the treatment of retinitis pigmentosa.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the product and process of making in Group I share the special technical feature of the kit and the specified enzymes. The method of treatment in Group II does not share this special technical feature.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Art Unit: 1657

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 (a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa J. Hobbs whose telephone number is 571-272-3373. The examiner can normally be reached on Monday through Thursday, 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1657

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Lisa J. Hobbs
Primary Examiner
Art Unit 1657

LJH